UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,160	04/30/2001	Mark R. Fichtner	42390.P5539C	5404

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EXAMINER
HERNANDEZ, NELSON D

ART UNIT	PAPER NUMBER
2612	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/846,160	FICHTNER, MARK R.
	Examiner	Art Unit	
	Nelson D. Hernandez	2612	..

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>RCE received on 10/17/2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>15-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>15-18, 20-23 and 25-27</u> is/are rejected.

7)☒ Claim(s) <u>19 and 24</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the

fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114,

and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the

previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on October 17, 2005 has been entered.

Response to Amendment

2.   The Examiner acknowledges the amendments made on the claims filed

on October 17, 2005. Claims 15, 17-19 and 24 have been amended. Claims 1-

14 have been cancelled.

Response to Arguments

3.   Applicant's arguments with respect to claims 15, 17 and 18 have been

considered but are moot in view of the new ground(s) of rejection.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially
created doctrine grounded in public policy (a policy reflected in the statute) so as
to prevent the unjustified or improper timewise extension of the "right to exclude"
granted by a patent and to prevent possible harassment by multiple assignees.
A nonstatutory obviousness-type double patenting rejection is appropriate where

the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.   **Claims 15, 17, 18, 20, 23 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 5 and 6 of U.S. Patent No 6,256,059 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 15 of the present application is encompassed by the combination of claims 5 and 6 of the referenced patent '059, since the claim is a broader version of the patented claims.**

Regarding claim 15, claim 15 in the present application presents:

A method for transferring image information between an imaging device and a host system, said method comprising: the host system detecting a coupling of the imaging device to the host system (see claim 6 of patent '059, lines 5-7, *"the API notifying the application software the imaging device is connected to the host system"*); in response to detecting the coupling, said host system

automatically detecting a type of the imaging device (see claim 6 of patent '059, lines 2-4, "*detecting a successful opening of the imaging device driver if the imaging device is connected to the host system*"), identifying application software associated with the type of imaging device (see claim 6 of patent '059, lines 2-4), and launching the application software for requesting image information transferred from the imaging device to the host system (see claim 5 of patent '059, lines 3-5, "*application software, executing on the host system, creating and initializing and imaging device Applications Programming Interface (API)*"; see also lines 11-13, "*subsequent to the API successfully opening of the imaging device driver, transferring the image information from the imaging device to the host system*"); and in response to the request, the application software periodically attempting to communicate with the imaging device to cause said image device to cause said image information is transferred from the imaging device to the host system, wherein the image information is transferred from the imaging device to the host system once the application software successfully communicates with the imaging device (see claim 5 of patent '059, lines 6-10, "*the API periodically attempting to open an imaging device driver on the host system to the host system to communicate image information with the imaging device and wherein the imaging device driver is opened if the imaging device is connected with the host system*").

   Claim 15 in the application is different from the application in the sense that it requires that the image information requires one or more images previously captured by the imaging device prior to be coupled with the host system.

However, Official Notice is taken that transferring image information including one or more images previously captured by the imaging device prior to be coupled to a host system to the memory (i.e. hard drive) of said host system is notoriously well known in the art and would have been obvious to one of ordinary skill in the art at the time the invention was made to transfer image information including one or more images previously captured by the imaging device prior to be coupled to a host system with the motivation of freeing space from the memory so as to be reused at a later time.

Regarding claim 17 and 18, claims 17 and 18 teaches a system and computer readable medium respectively that are encompassed to the limitations of the method claim 15 in the application that is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claims 5 and 6 of US Patent 6,256,059 B1 in view of ()

Regarding claim 20, claim 20 teaches limitations of the combination of claims 5 and 6 of the patent '059 (see claim 5 of patent '059, lines 3-5 and claim 6, lines 2-7).

Regarding claim 23, claim 23 teaches limitations of the combination of claims 5 and 6 of the patent '059 (see claim 5 of patent '059, lines 3-5 and claim 6, lines 2-7).

Regarding claim 25, claim 25 teaches limitations of the combination of claims 5 and 6 of the patent '059 (see claim 5 of patent '059, lines 3-5 and claim 6, lines 2-7).

6.   **Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No 6,256,059 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 of the present application is encompassed by claim 8 of the referenced patent '059, since the claim is an equivalent version of the patented claims.**

7.   **Claims 21, 22, 26 and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combination of claims 5 and 6 of U.S. Patent No. 6,256,059 B1 in view of Endsley, US Patent 5,841,471.**

Regarding claim 21, the limitation of having the port of the host system being one of a USB (universal serial bus) compatible port and an IEEE 1394 compatible port is not present in the patent '059. ~~Claims 5-6 of~~

However, Endsley teaches a digital camera connected to a computer, which comprises the steps of detecting if the imaging device is connected to the computer (microprocessor 38 detects a connection between camera 10 and computer 12 via USB device interface 40; col. 2, line 66 – col. 3, line 67; col. 4, lines 1-15), signaling an operating system, executing on the computer, that the imaging device is connected to the computer (microprocessor 38, col. 3, lines 54-67), and transferring the image information from the imaging device to the computer using preinstalled imaging device driver upon the operating system being signaled that the imaging device is connected to the computer

(microprocessor 38 uses USB driver software preinstalled in the camera, col. 3, lines 55-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the port of the host system being one of a USB (universal serial bus) compatible port. This would be advantageous because by using the USB port The motivation to do so would have been to connect to other devices such as keyboards, printers etc. and also to supply power to the camera as suggested by Endsley (Col. 2, lines 49-65).

Regarding claim 22, limitations have been discussed in claim 15.

Regarding claim 26, limitations have been discussed in claim 21.

Regarding claim 27, limitations have been discussed in claim 15.

Allowable Subject Matter

8.   **Claims 19 and 24** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9.   The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 19, the main reason for indication of allowable subject matter is because the prior art fails to teach or reasonably suggest that a port driver of an operating system (OS) executed within the host system signaling when the imaging device is connected to the port of the host system; an imaging device driver associated with the imaging device signaling the port driver upon

successfully opening the imaging device; and the imaging device driver acquiring the image information from the imaging device via the port driver and forwarding the acquired image information to the application software in conjunction with limitations of claims 15 and 16.

Regarding claim 24, the main reason for indication of allowable subject matter is because the prior art fails to teach or reasonably suggest that a port driver of an operating system (OS) executed within the host system signaling when the imaging device is connected to the port of the host system; an imaging device driver associated with the imaging device signaling the port driver upon successfully opening the imaging device; and the imaging device driver acquiring the image information from the imaging device via the port driver and forwarding the acquired image information to the application software in conjunction with limitations of claims 18 and 23.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernandez whose telephone number is (571) 272-7311. The examiner can normally be reached on 8:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Yen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Nelson D. Hernandez
Examiner
Art Unit 2612

NDHH
January 6, 2006

NGOC-YEN VU
PRIMARY EXAMINER